

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCE

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Ex parte MICHELLE A. MILLER, P GAYLE MUJICA, ROGER S. FALASTER,  
LISABETH C. MAIN, LISA SMOOT and BEA R. ATON

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Application 10/028,327

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was electronically received at the Board of Patent Appeals and Interferences (BPAI) on November 7, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner. The matters requiring attention prior to docketing are identified below.

A review of the file indicates that on March 31, 2005, Appellants filed an Appeal Brief under the rules set forth in 37 CFR § 41.37(c). However, the Appeal Brief filed on March 31, 2005, does not fully comply with the new rules under 37 CFR § 41.37(c).

37 CFR § 41.37(c) states in part:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(I) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(I) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(ix) ***Evidence appendix.*** An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) ***Related Proceedings Appendix*** – Copies of any decisions rendered by a court or the Board in any proceeding identified by the examiner in the “Related Appeals and Interference” section of the answer.

An in-depth review of the Appeal Brief indicates that the following sections are missing from the Appeal Brief filed September 6, 2005:

- 1) “Evidence Appendix,” as set forth in 37 CFR § 41.37(c)(1)(ix).
- 2) “Related Proceedings Appendix,” as set forth in 37 CFR § 41.37(c)(1)(x).

It is required that either a supplemental Appeal Brief be submitted that is in

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compliance with 37 CFR § 41.37(c) or for the examiner to present a statement regarding the position taken on the missing appendixes in a supplemental Examiners Answer, see MPEP § 1205.03. For more information on the Board's new rules, please see the web page entitled "More Information on the Rules of Practice Before the BPAI," Final Rule at:

<http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html>.

On December 12, 2005, an Examiner's Answer was mailed. A review of the Examiner's Answer reveals that it is not in compliance with the headings as required under 37 CFR § 41.37(c).

An in-depth review of the Examiner's Answer mailed on December 12, 2005, reveals that under the heading Evidence Relied Upon, all of the prior art relied upon on was not listed. Spencer et al., U.S. Patent no. 5,603,021 was not listed under the heading Evidence Relied Upon, but was used in rejecting claims 2-4, 6-8 and 10-12 under 35 U.S.C. § 103(a) on page 4, of the Examiner Answer. The MPEP 1207.02(A) states:

A) CONTENT REQUIREMENTS FOR EXAMINER'S ANSWER. The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

(8) *Evidence Relied Upon*. A listing of the evidence relied on (e.g., patents, publications, admitted prior art), and, in the case of nonpatent references, the relevant page or pages.

Proper correction of the Examiner's Answer is required.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1) to notify appellants to file a supplemental Appeal Brief in compliance with 37 CFR § 41.37 or for the examiner to present a statement regarding the position taken on the missing appendixes in a supplemental Examiners Answer, see MPEP § 1205.03;
- 2) if necessary, vacate the Examiner's Answer mailed December 12, 2005, and issue a revised Examiner's Answer in response to a supplemental Appeal Brief;
- 3) to issue a revised Examiner's Answer, setting forth all of the prior art the Examiner relied upon in the rejections on appeal; and
- 4) for such further action as may be appropriate.

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